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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,141	12/12/2000	James J. Fitzgibbon	70333	5535

22242 7590 09/28/2006

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
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CHICAGO, IL 60603-3406

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/735,141

Applicant(s)

FITZGIBBON ET AL.

Examiner

Brian A. Zimmerman

Art Unit

2612

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **EXAMINER'S RESPONSE**

#### **Status of Application**

In response to the applicant's amendment received on 8/18/06. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-11 and 13 are unpatentable for the reasons set forth in this office action:

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,2,5,7-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (6041410), Flick (6140939) and Waraksa (5412379).

Hsu teaches a garage door operating system that includes a fingerprint-communicating unit 14 which includes a fingerprint sensor 16, see figures 2 and 3. The communication unit also includes a transmitter 22 that sends a signal to the barrier operator where it is received and authenticated to open the garage door. Hsu does not expressly show the fingerprint comparison occurring at the operator, however in an analogous art, Flock teaches that either having the authentication comparison occur at the communicating unit or at the barrier operator are both equivalent methods with various pros and cons associated with each. See figures 5 and 6. Hsu does teach that communication from the key to the lock should be encoded or encrypted to prevent

cloning by interception. See col. 4 lines 52+. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the fingerprint authorization occur at the barrier operator as suggested by Flock since it would reduce the processing power necessary in the fingerprint communication unit.

In an analogous art, Waraksa teaches a rolling code used to mix up the id or unlocking code of the portable device to prevent cloning and unauthorized access. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have mixed a rolling code with the Hsu-Flick transmission since this would aid in preventing unauthorized access.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, Flick and Waraksa as applied to claims 1 and 2 above, and further in view of Nicholls.

Hsu-Flick-Waraksa does not teach the use of electroluminescent fingerprint sensors. Nicholls teaches of an electroluminescent fingerprint sensor such as TactileSense<sup>™</sup> by Who?Vison<sup>™</sup> as an improvement over other common fingerprint sensors. It would have been obvious to one skilled in the art at the time of invention to substitute Hsu's optical fingerprint sensor for Nicholls electroluminescent fingerprint sensor since Nicholls discloses an advantage of electroluminescent fingerprint sensors over existing fingerprint sensors, such as the immunity to the 'dry finger problem' that existed in fingerprint sensing technologies at the time of invention (Nicholls, pp 5). Who?Vison<sup>™</sup> also suggests the integration of such sensors into physical access control devices ("[xlvision.com/spinoffs](http://xlvision.com/spinoffs)").

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, Flick and Waraksa as applied to claim 1 above, and further in view of Toyoda.

Hsu-Flick-Waraksa does not teach the use of Charged Coupled Devices (CCDs). Toyoda et al. teaches the use of CCDs to sense fingerprints in the production of identity authentication devices (Fig. 1). It would have been obvious to one skilled in the art at the time of invention to substitute Hsu's optical fingerprint sensor for Toyoda et al's identity authentication device using a CCD since Toyoda et al suggest that his device be used to manage entrance and exit of individuals in restricted areas (Col 1, lines 38-40) and the use of Toyoda et al's identification device using CCD would provide an improved individual identification apparatus with a high recognition ability (Col 2, lines 38-42).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, Flick and Waraksa as applied to claim 1 above, and further in view of Fitzgibbon (5751224).

Hsu-Flick-Waraksa does not expressly show the transmitter comprising a wall controller. In an analogous art, Fitzgibbon '224 shows the use of transmitter 34 that is a wall controller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the Hsu-Flick transmitter on the wall of the garage since such would eliminate the need for the user to physically carry around the transmitter.

### ***Response to Arguments***

The applicant argues that the references do not teach using both fingerprint and rolling code. Hsu and Flick are not cited for teaching both fingerprint and rolling codes. Hsu teaches the use of fingerprint authentication to access a garage door. Flick teaches transmitting fingerprint codes so the authorization is processed at the secure location. Waraksa teaches the use of rolling codes. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues that neither Flick nor Hsu would be modified by Waraksa's teaching of a rolling code, because neither of these references needs additional security. The applicant's argument makes an (an unsupported) assumption that the references are complete and would never need improvements. This line of reasoning would lead us to the position that a patent could never be used as a base reference in an obviousness rejection, because the patent is complete and operates as is. The applicant's argument is unpersuasive.

The applicant argues that there is no motivation to combine the Waraksa rolling code with Flick and Hsu because neither Flick nor Hsu describes that their system would be inadequate. These arguments are not persuasive. Following the applicant's argument, the only references that could be modified are those stating that their system is inadequate. Publications or patents that state their inadequacies would be extremely rare if any exist at all, and therefore, obviousness rejections would never be

appropriate. Requiring that the primary reference(s) has to suggest that it is inadequate before an obviousness rejection can be made is completely unsupported by statute or case law.

The applicant argues that the motivation or suggestion must be contained within the references themselves. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to have the fingerprint authorization occur at the barrier operator as suggested by Flock since it would reduce the processing power necessary in the fingerprint communication unit, and it would have been obvious to have mixed a rolling code with the Hsu-Flick transmission since this would aid in preventing unauthorized access.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on 7 am to 4 pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian A Zimmerman  
Primary Examiner  
Art Unit 2612

A handwritten signature in black ink, appearing to be 'B. Zimmerman', written over the printed name and title.

BZ